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| RYAN, PATRICK A | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/675,468

Applicant(s)

KARAOGUZ ET AL.

Examiner

PATRICK A. RYAN

Art Unit

2427

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is made in response to Amendment Under 37 CFR 1.111 ("Reply"), filed July 31, 2009. Applicant has amended Claims 1, 11, and 21; no claims have been added; and no claims have been cancelled. As amended, Claims 1-40 are presented for examination.

2. In Office action of May 11, 2009 ("Office Action"):

Claims 1-8, 11-18, 21-28, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boston et al (US Patent 7,212,730), hereinafter "Boston", in view of Tomsen (US Patent 7,103,908 B2).

Claims 9, 10, 19, 20, 29, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Boston and Tomsen as applied to Claim 1 and in further view of Oh (US PGPUB 2002/0161713 A1).

Claims 32-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Boston and Tomsen as applied to Claim 1 and in further view of Wood et al. (US PGPUB 2002/0054752 A1), hereinafter "Wood".

Response to Arguments

3. Applicant's arguments with respect to Claims 1, 11, and 21 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-8, 11-18, 21-28, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boston et al (US Patent 7,212,730), hereinafter "Boston", in view of Yen et al. (6,668,278 B1), hereinafter "Yen".

6. In reference to claims 1 and 21, Boston teaches a method (see Figure 8 described in Col. 8 Lines 52-53) of and processor (see processor 3000 of Figure 30 described in Col. 25 Lines 10-15) for providing an advertisement in a communication channel, the method and processor operation comprising:

receiving the advertisement for display on a television within a home (step 965 of Figure 9 described in Col. 10 Lines 2-4);

displaying media corresponding to at least a portion of a scheduled advertisement on said television based on said scheduling (step 935 of Figure 9 described in Col. 9 Lines 55-58; with further reference to steps 1010 and 1015 of Fig. 10 Col. 10 Lines 22-31),

Boston teaches scheduling, based on times designated by content provider, an advertisement for viewing at the user's location (step 945 of Figure 9 described in Col 9 Lines 58-61). Additionally, Boston discloses the display of but does not teach automatically display, without user interaction and prior to viewing said received

advertisement, a notification of the advertisement on said television, and scheduling, based on input from a user provided after said display of said notification.

In a similar field of invention, Yen teaches "a method and system for receiving incoming information from multiple information sources, both interactive and passive, and for engagingly presenting that information to a recipient on a presentation interface" (Abstract). Yen additionally discloses that the subject matter for information items can include "which products are advertised or otherwise featured on a broadcast show or other information item" (Col. 7 Lines 29-39). Yen's system includes a Background Element 121 for receiving and processing information and a Foreground Element 122 for presenting identifiers for information to be selected by the recipient (shown in Figs. 1 and 2, as introduced in Col. 5 Line 53—Col. 6 Line 11). Foreground Element 122 also functions to provide a notification to the user when particular information items are received ("present an indicator for the item", as Yen discloses in Col. 11 Lines 43-52; with further reference to Col. 13 Lines 19-27). Additionally, Yen demonstrates that a once the user is notified, the user can schedule the information for display immediately or add the information item to a set of information items (Col. 11 Lines 24-40).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teaches of Boston regarding the presentation of the availability of advertisement content with Yen's teaching of automatically displaying a notification allowing a user to view an information item immediately or add the information item to a list, so as to "improve the capability of the user to manage and record information from a

variety of information sources" (as Yen discusses in Col. 2 Lines 14-24; with further reference to Col. 2 Line 57—Col. 3 Line 3).

7. In reference to claims 2 and 22, the combination of Boston and Yen teach a method of and processor for presenting data representative of said received advertisement (Figure 12 described by Boston in Col. 12 Lines 18-20) in an available slot in a channel guide (detailed edit schedule 1200 of Figure 12 described by Boston in Col.12 Lines 4-12).

8. In reference to claims 3 and 23, the combination of Boston and Yen teach a method of and processor for displaying data representative of said received advertisement where the advertisement is one or more of graphical data, textural data, audio data and video data (disclosed by Boston in Col. 2 Lines 56-65).

9. In reference to claims 4 and 24, the combination of Boston and Yen teach a method of and processor for establishing a user profile (Figures 3 and 4 described by Boston in Col. 5 Lines 35-67 and Col. 6 Lines 1-54) indicating at least a particular type of advertisement that is to be received (detailed edit schedules 610 described by Boston in Col. 6 Lines 60-63).

10. In reference to claims 5 and 25, the combination of Boston and Yen teach a method of and processor for determining whether data representative of said particular type of advertisement is within said established profile (step 840 of Figure 8 described by Boston in Col.9 Lines 4-10); and if said data representative of said particular type of advertisement is within said established profile, receiving said particular type of advertisement (step 860 of Figure 8 described by Boston in Col.9 Lines 10-12).

11. In reference to claims 6 and 26, the combination of Boston and Yen teach a method of and processor for identifying a gap that exists in a schedule in a channel guide displayed on said television (step 835 of Figure 8 described by Boston in Col 8 Lines 52-67 and Col. 9 Lines 1-16; with further reference to Edit Schedule 815 implemented in Step 810 and depicted in Figure 12 described in Col. 12 Lines 4-32).

12. In reference to claims 7 and 27, the combination of Boston and Yen teach a method of and processor for scheduling at least one advertisement for display at a time corresponding to said identified gap (decision 1040 of Figure 10 described by Boston in Col. 10 Lines 44-48).

13. In reference to Claims 8, 18, and 28, the combination of Boston and Yen teaches a method for granting permission to schedule at least one advertisement for display within said identified gap (Boston teaches the identification of gaps in the program schedule by way of Edit Schedule 815 implemented in Step 810 and depicted in Figure 12 described in Col. 12 Lines 4-32; with further reference to steps 1010 and 1015 of Fig. 10 Col. 10 Lines 22-31. In addition, Yen teaches a method of scheduling the information for display immediately or adding the information item to a set of information items, as described in Col. 11 Lines 24-40).

14. In reference to claims 11, 12, 13, 14, 15, 16, and 17, the combination of Boston and Yen teach a machine-readable storage having stored thereon, a computer program having at least one code section for providing an advertisement in a communication network (disclosed by Boston in Col. 25 Lines 16-25), the at least one code section

being executable by a machine (disclosed by Boston in Col. 25 Lines 25-27) for causing the machine to perform the method of claims 1 through 10, as addressed above.

15. In reference to claim 21, the combination of Boston and Yen teach a system for providing an advertisement in a communication network (system diagram shown in Figure 6 as described by Boston in Col. 6 Lines 55-63) for causing the machine to perform the method of claims 1 through 10, as addressed above.

16. In reference to claim 31, the combination of Boston and Yen teach a processor that is a media management system processor (processor 3000 of Figure 30 disclosed by Boston in Col 24 Lines 1-5).

17. Claims 9, 10, 19, 20, 29, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Boston and Yen as applied to Claim 1 and in further view of Oh (US PGPUB 2002/0161713 A1).

18. In reference Claims 9, 10, 19, 20, 29, and 30 the combination of Boston and Yen do not teach a method for offering a reward for scheduling the advertisement for display within a personal advertisement channel. In addition, Boston and Yen do not teach a method where said reward comprises at least one of free programming and reduced programming cost. However, Oh teaches a reward method of providing advertisement content to a user in which multimedia content prices are discounted in an incremental

fashion dependent upon when the user elects to view the given advertisement (as disclosed in Paragraph 0054). In addition, if the user elects to view the advertisement while the multimedia content is being played, the system provides the said multimedia content for free (as disclosed in Paragraph 0054 Lines 8-12).

In view of Oh's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of advertisement insertion and scheduling disclosed by Boston and Yen to incorporate a method discounting programming content based on the event of a user scheduling an advertisement to be viewed. It would be advantageous to have an advertising system that rewarded the user for scheduling an advertisement for viewing because the user would be more likely to view additional program content and related advertisements in exchange for free or reduced cost programming (as Oh describes in Paragraph 0011).

19. Claims 32-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Boston and Yen as applied to Claim 1 and in further view of Wood et al. (US PGPUB 2002/0054752 A1), hereinafter "Wood".

20. In reference to claim 32, the combination of Boston and Yen teaches the method according to claim 1, however the combination does not explicitly disclose scheduling for display one or more personal media channels on said television.

In a similar field of invention, Wood teaches a method and apparatus for organizing locally stored television recordings into personal channels (Abstract). In

particular, Wood demonstrates in Figure 10 that a user can create a personal channel within a personal channel guide for displaying the recorded television shows according to a schedule (as described in Paragraphs [0061-0064]). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the scheduling and displaying of locally stored advertisements, as taught by the combination of Boston and Yen, to include a personal channel interface for organizing locally stored media content, as taught by Wood, in order to provide the user with a means to organize and consolidate the locally stored content (as Wood suggests in Paragraphs [0008-0010]).

21. In reference to claim 33, the combination of Boston, Yen, and Wood teaches the method according to claim 32, comprising authoring said one or more personal media channels by friends and family members of said user (Wood teaches that multiple user, for examiner within a household, can provide criteria information regarding the personal channels, as disclosed in Paragraph [0055]).

22. In reference to claim 34, the combination of Boston, Yen, and Wood teaches the method according to claim 32, comprising scheduling said received advertisement as an advertisement channel in a personal media channel guide (Boston teaches scheduling advertisements for a channel using "edit schedules for commercials", as disclosed in Col. 32-40. In addition, Wood teaches the organization of locally stored media into personal channels, as shown in Fig. 10 and described in Paragraphs [0061-0064]).

23. The limitations of claim 35 have been addressed with claims 32 and 11.

24. The limitations of claim 36 have been addressed with claims 33 and 11.

- 25. The limitations of claim 37 have been addressed with claims 34 and 11.
- 26. The limitations of claim 38 have been addressed with claims 32 and 21.
- 27. The limitations of claim 39 have been addressed with claims 33 and 21.
- 28. The limitations of claim 40 have been addressed with claims 34 and 21.

Conclusion

29. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PATRICK A. RYAN whose telephone number is (571)270-5086. The examiner can normally be reached on Mon to Thur, 8:00am - 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Scott Beliveau can be reached on (571) 272-7343. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. A. R./
Examiner, Art Unit 2427
Friday, November 20, 2009

/Scott Beliveau/
Supervisory Patent Examiner, Art Unit 2427